

In re Application of:

Fan et al.

Application No.: 10/030,441

Filed: May 16, 2002

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PATENT

Attorney Docket No.: UCI1150-1

Remarks/Arguments

Claims 1, 2 and 4-59 were pending before this response. Claims 37-41 have been canceled without prejudice, preserving Applicant's right to pursue the canceled subject matter in a continuing application. Claims 1 and 4 have been amended as set forth in the above "Listing of the Claims." As amended, the claims are supported by the specification and the original claims. Thus, upon entry of the amendments, claims 1, 2 and 4-12 will be pending.

Objections to the Specification and Claims

The specification of the present application was objected to as allegedly containing an embedded hyperlink and/or other form of browser-executable code on page 27. It is respectfully submitted that any embedded hyperlink, as described in M.P.E.P. § 608.01, has been deleted. Accordingly, withdrawal of the objection is respectfully requested.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Applicant respectfully traverses the rejection of claims 37-41 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However, to advance prosecution and reduce the issues, claims 37-41 have been canceled without prejudice, preserving Applicant's right to pursue the canceled subject matter in a continuing application. Consequently, Applicant respectfully submits that the rejection is moot as to canceled claims 37-41 and respectfully requests withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

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Rejection Under 35 U.S.C. § 112, First Paragraph

Applicant respectfully traverses the rejection of claims 1-2 under 35 U.S.C. § 112, first paragraph, for containing subject matter allegedly not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the invention at the time of filing of the Application. In particular, it is alleged in the Office Action at page 4 that SEQ ID NO:8 is a polynucleotide of the JSRV sequence having accession number AF105220, and was introduced as new matter in the amendment filed May 26, 2004. Applicants assert that, like the other sequences that were introduced by the amendment filed May 26, 2004, SEQ ID NO:8 is not new matter because it was spelled out in the specification as originally filed. The Examiner's attention is respectfully drawn to page 23, lines 5-7 of the specification as filed, that describes "a JSRV polynucleotide of the invention includes the JSRV sequence having accession number AF105220. In addition, a polynucleotide of the invention includes a fragment of the sequence having accession number AF105220 as well as sequences subject to site-directed mutagenesis." Further, page 66, lines 2-3, states that "[t]he nucleotide sequence of JSRV₂₁ has been deposited in GenBank under accession no. AF105220." As is evident by the amendment to the claim 1 and the subsequent cancellation of claim 3, SEQ ID NO:8 was inserted into the specification to identify the entire nucleotide sequence of JSRV₂₁. SEQ ID NO:8 does not describe a polynucleotide of the JSRV sequence having accession number AF105220. Accordingly, SEQ ID NO:8 was spelled out in the specification as filed, and is not new matter. Reconsideration and withdrawal of the rejection are respectfully requested.

Applicant respectfully traverses the rejection of claims 37-41 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, and for containing subject matter allegedly not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the invention at the time of filing of the Application. However, to advance prosecution and reduce the issues, claims 37-41 have been canceled without prejudice, preserving Applicant's right to pursue the canceled subject matter in a continuing application. Consequently, Applicant respectfully submits that the

rejections are moot as to canceled claims 37-41 and respectfully requests withdrawal of the rejections.

Rejection Under 35 U.S.C. § 103

Applicant respectfully traverses the rejection of claims 37-41 under 35 U.S.C. § 103(a) as allegedly being unpatentable over York in view of Salk et al. (US Pat. No. 6,017,543; hereinafter “Salk”) and Gilbert et al. (US Pat. No. 5,017,543; hereinafter “Gilbert”). However, to advance prosecution and reduce the issues, claims 37-41 have been canceled without prejudice, preserving Applicant’s right to pursue the canceled subject matter in a continuing application. Consequently, Applicant respectfully submits that the rejection is moot as to canceled claims 37-41 and respectfully requests withdrawal of the rejection.

Applicant respectfully traverses the rejection of claims 4-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kasahara et al in view of York. As acknowledged in the Office Action at page 9, SEQ ID NO:8 is “free of the prior art of record.” In order to reduce the issues and advance prosecution, claim 4 has been amended to incorporate the limitations of amended claim 1. Accordingly, Applicant submits that amended claim 4 (and claims 5-12 dependent therefrom) are not *prima facie obvious* over the combined teachings of Kasahara and York, and withdrawal of the rejection is respectfully requested.

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CONCLUSION

In view of the amendments and above remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect respectfully is requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application. Please charge any additional fees, or make any credits, to Deposit Account No. 50-1355.

Respectfully submitted,


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